

Doc Code: AP.PRE.REQ



Based on PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

062807-0040

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or Printed
Name _____

Application Number

10/076,624

Filed

February 19, 2002

First Named Inventor

Yoko KUMAGAI, et al.

Art Unit

2131

Examiner

Trang T. Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

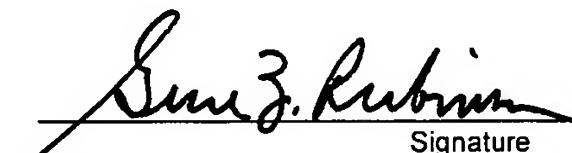
assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.
Registration number
33,351

☐

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34


Signature

Gene Z. Robinson

Typed or printed name

202.756.8602

Telephone number

August 2, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Appeal has been taken of the rejection of claims 11 through 20 in the final Office Action dated March 28, 2006.

Claim 12 stands rejected under the second paragraph of 35 U.S.C. § 112. The rejection is traversed. The Office Action states that the claim is “generally narrative and indefinite, failing to conform with current U.S. practice.” No portion of the claim has been identified in the Office Action in support of the holding of indefiniteness.

Although the Office Action is accurate in stating that the controlling statutory section requires that a claim particularly point out and distinctly claim the subject matter which applicant regards as the invention, there is nothing in the statute that defines what is “narrative.”

Claim 12 is dependent from parent claim 11, a method claim. Claim 11 has not been rejected under 35 U.S.C. § 112. Claim 12 further defines the step in claim 11 of generating, by the registration authority, a certificate issuing request, by reciting that the contents signed by the registration authority is a predetermined identifier to specify information to be certified by the public key certificate of the end entity. It is submitted that the recitation of claim 12 contains terms of art well understood by a person of ordinary skill in the art of encryption. The Office Action has presented no explanation, nor cited any recitation of claim 12, to support a conclusion that a person of ordinary skill in the art would not have understood what subject matter applicant regards as invention. Withdrawal of the rejection is respectfully solicited.

Claims 11 through 20 stand rejected under 35 U. S. C. § 102(e) as being anticipated by U.S. patent 6,990,583 (Matsuyama). The rejection is traversed. Claim 11, the only independent claim, recites, among other things, the requirement that the public key certificate includes “contents signed by the registration authority and registration authority signature.” Matsuyama, it is submitted, contains no such teaching.

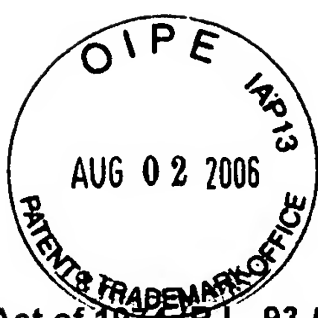
The Office Action has read this claim requirement on the reference disclosure of Fig. 19, columns 22, 23. This portion of Matsuyama (column 23, lines 15, 16) refer to Figs. 6 and 7 for description of the public key certificate and its contents. There is nothing in either of those figures, nor of their description in the specification, that indicates that the public key certificate is to contain contents signed by the registration authority and registration authority signature.

The lack of such teaching by Matsuyama was emphasized to Examiner Doan in an interview conducted June 29, 2006. Examiner Doan directed attention to column 6, lines 47-57 copies below, asserting that this portion of the reference discloses the claim requirements at issue.

In the public-key-encryption data-communication-system forming method, the public key certificate may include a common electronic signature of the public-key-certificate issuer authority which issues the public key certificate, and one of a root registration authority, a registration authority, a service provider, and a user device which perform processing for the verification of one public key certificate issued by the public-key-certificate issuer authority may perform offline processing for the verification of different public key certificates issued by a single public-key-certificate issuer authority.

It is submitted that this excerpt of Matsuyama describes the contents of the public key certificate only to the extent that it may contain a common electronic signature of the public-key-certificate issuer authority which issues the public key certificate. The remaining portion of the excerpt is directed to identifying which elements may perform offline processing for the verification of different public key certificates issued by a single public-key-certificate issuer authority. The recitation of root registration authority and registration authority in the excerpt are the latter elements that perform the processing function. It is submitted that no person skilled in the art would understand the public key certificate to contain one of the recited authorities. The authorities are entities that perform functions or generate data, authorities are not elements of a certificate. This position, it is submitted, is substantiated by the detailed examples of the public key certificate illustrated in Figs. 6

and 7, upon which the Office Action has relied. The root registration authority and registration authority are not shown in those figures. Withdrawal of the rejection is respectfully solicited.



Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.